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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,255	11/02/2001	Irwin Kotovsky	K0T0V-11	1332

7590

09/12/2002

Ansel M. Schwartz  
Suite 304  
201 N. Craig Street  
Pittsburg, PA 15213

EXAMINER

AMARANTIDES, JOHN

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/005,255

Applicant(s)

KOTOVSKY, IRWIN

Examiner

John Amarantides

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 2, 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1 The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "11" and "18" have both been used to designate the pre-cast plaster panel and the one piece layer, which appear to be the same part. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because page 12, line 7 uses "comprises" and line 8 uses "adapted." Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: Page 6, line 2 moled should be changed to molded.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutain (US006095671A).

a. In regard to claims 1, 12 and 15, Hutain in Figures 2D and 2E discloses a lighting assembly (206) with a trim housing (122) inside a box housing (108) and 3 lamps (174c), with a fitted one piece aperture plate (210) with apertures (212) a lined with respect to the lights. Hutain in Figure 2D discloses a holder/transition piece between the one-piece aperture plate (210) and the ceiling.

***Claim Rejections - 35 USC § 103***

7. Claims 2 – 11, 13, 14, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutain (US006095671A).

a. Hutain applies in the same manner as above. Hutain discloses multiple embodiments for configurations, lamp types, power requirements and cooling that can be interchanged to meet the intended use by the user.

b. In regard to claims 2, 13 and 16, Hutain in Figure 1B discloses a trim ring (126) with a cylindrical (shield) ring wall (146) and an extender ring (124) for lamp positioning.

c. In regard to claim 3, Hutain in Figure 1B discloses an individual lamp trim housing (122) and Figure 2D discloses a multiple lamp trim housing (122) to hold lamps.

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d. In regard to claim 4, Huta in Figure 2D discloses a holder/transition piece between the one-piece aperture plate (210) and the ceiling.

e. In regard to claims 5, 7, 14 and 17, nevertheless, it is old and well known that the one piece layer can be made of any suitable material and the method for securing the layer to the ceiling is depended on the selected materials. Plaster or wallboard can be taped, spackled, sanded, primed and painted to eliminate an unsightly joint, which is industry practice in residential and commercial construction.

f. In regard to claim 6, Huta in Figure 2A discloses mounting arms (104, 102 (not shown)) or bracket. Nevertheless, it is old and well known that the type and quantity of mounting devices would be determined by the size, weight and materials used for the lighting apparatus and the ceiling.

g. In regard to claim 8, Huta in Figure 2D discloses transformers (208) connected to lamps (174c) and a junction box (106) to provide electricity.

h. In regard to claim 9, Huta in column 14, lines 64 – 67 discloses that a gimbaled apparatus may be affixed to the trim.

i. In regard to claim 10, Huta in Figure 1B, discloses a cylindrical ring wall (146) with an edge, but does not say what shape it forms. Nevertheless, it is old and well known that the edge must have a surface face and the shape would be dependent on the gumball ring swing and lamp attachment and functional movement.

j. In regard to claims 11 and 19, Huta in Figure 2E discloses an asymmetrical pattern of holes (212). Nevertheless, it is old and well known that the holes (212) would

either have to be cut or molded dependent on the material selected for the one-piece aperture plate (210).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutain (US006095671A) as applied to claim 1 above, and further in view of Merko (US005353211A).

a In regard to claim 18, Hutain does not teach a method of forming a fixture or panel with the process tied to the material selected for the lamp assembly. Merko in the Abstract discloses that a light housing can be molded of one piece of plastic. Nevertheless, it is old and well known that light fixtures and panels can be made of metal, plastic or other materials requiring molding or cutting. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use Merko's molding method to mold the housing and panel of Hutain's in order to enhance the fixture and panel aesthetics and minimize field construction of the lighting assembly.

#### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to multiple recessed lighting fixtures within a housing:

- a. US006357891B1 to Newbold et al.
- b. US006234644B1 to Kotovsky et al.
- c. US005581448A to Harwood
- d. US004025777 to Hayakawa

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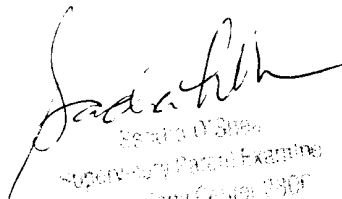
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Amarantides whose telephone number is 703-305-4013. The examiner can normally be reached 8:00am-4:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-3329.

JA 

September 3, 2002

  
Sandy O'Shea  
Supervisory Patent Examiner  
Technology Center 1900